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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/352,951 07/14/99 OHE

M 503.33612CX1

020457 IM52/0221  
ANTONELLI TERRY STOUT AND KRAUS  
SUITE 1800  
1300 NORTH SEVENTEENTH STREET  
ARLINGTON VA 22209

EXAMINER

WILLIS

ART UNIT

PAPER NUMBER

1756

DATE MAILED:

02/21/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/352,951

Applicant(s)

OHE ET AL.

Examiner

Shean C Wu

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12 and 15 is/are allowed.
- 6) ☐ Claim(s) 1-11, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 08/405,887.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. Therefore, the amendment filed 1/22/2001 has been entered.

***Claim Rejections - 35 USC § 112***

2. Claims 1-11 and 13 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicants regard as their invention. Evidence that claims 1-15 fail to correspond in scope with that which applicants regard as the invention can be found in the specification filed 7/14/1999. In the original specification, applicants have stated that liquid crystal composite material includes a liquid crystal chemical compound, and this statement indicates ~~that the~~ invention is different from what is defined in the claims because the present claims have stated liquid crystal composite material includes a liquid chemical compound.

3. Claim 14 recites the limitation " $d/l \geq 2.0$ " in liquid crystal display device. There is insufficient antecedent basis for this limitation in the claim because pixel and common electrodes are not defined in Claim 12,

***Claim Rejections - 35 USC § 103***

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Klanderman et al. (US 3,960,748).

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The reference discloses a nematic liquid crystal composition having a resistivity of about  $1 \times 10^8$  to  $1 \times 10^{10}$  ohm-cm. The reference differs from the claim in that the claimed liquid crystal composite material for use in a liquid crystal layer having a display device with an electric field having a component predominantly in parallel with a pair of substrates. The use of the composite is given little weight as the claimed subject matter is drawn to a composition. See *In re Pearson*, the terms merely setting forth intended use for, or a property inherent in, an otherwise old composition do not differentiate claimed composition from those known to prior art (181 USPQ 641). Also, accordingly, claims drawn to a new method of using either an old or "obvious" composition, wherein the method has unobvious beneficial or useful effects, have been found patentable even though the composition itself could not be patented. *In re Shetty*, (566 F.2d 81, 195 USPQ 753 C.C.P.A. 1977), the case states that mere recitation of new use for old composition does not render composition patentable. Therefore, it would have been obvious to those skilled in the art to make the claimed composite material because the reference teaches the composite material having the same properties as the claim.

***Allowable Subject Matter***

5. Claims 12 and 15 are allowed.
6. Claim 8 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

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7. Claims 9-11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

8. The rejections over Jubb et al. and Nolan et al. in the previous Office Action are still maintained because the present invention (Claims 1-7) is claimed a liquid crystal composite material. Also, see the section 4 in this Office Action. Mere recitation of new use for old composition does not render composition patentable.

#### ***Response to Arguments***

9. Applicant's arguments filed 1/22/2001 have been fully considered but they are not persuasive. See section 8. Applicant's arguments with respect to claims 1-11 and 13-14 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

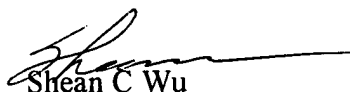
10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shean C Wu whose telephone number is 703-308-3956. The examiner can normally be reached on Monday-Friday 9:30 -6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703-308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are 703-306-3429 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Shean C Wu  
Primary Examiner  
Art Unit 1756

SCW  
February 18, 2001.